THE FOOTBALL ASSOCIATION PREMIER LEAGUE LTD & ANOR v. BAR THEORY SDN BHD & ORS

HIGH COURT MALAYA, KUALA LUMPUR
AZLAN SULAIMAN JC
[ORIGINATING SUMMONS NO: WA-24IP-14-07-2022]
16 NOVEMBER 2022

Abstract – *The acts of showing, playing, screening, streaming to the public and/or communicating to the public in business premises or otherwise, copyrighted works of the whole, or a substantial part of it and/or causing the aforementioned, without the consent of the copyright owners, is an act of copyright infringement under s. 36 of the Copyright Act 1987.*

INTELLECTUAL PROPERTY: *Copyright – Infringement – Restaurant bar live-screened earlier Premier League matches without requisite subscription, authorisation, license or permission – Whether communication to public – Whether performance, showing or playing to public – Whether act amounted to copyright infringement – Copyright Act 1987, ss. s. 13(1)(aa), 13(1)(b) & 36*

The first plaintiff was primarily involved in the business of organising the English Premier League competition. It also controlled the worldwide audio-visual rights to all telecasts of Premier League matches – live and delayed – by licensing those audio-visual rights and transmission of audio-visual coverage of the matches to broadcasters in territories all around the globe. In Malaysia, that license was given exclusively to the second plaintiff, who provided television and broadcasting under the name and style of 'ASTRO'. That license included the right to record, reproduce and/or re-broadcast the matches to its fee-paying subscribers. The plaintiff copyrighted their respective artistic works/films ('copyrighted works'). On the instigation of its directors, namely the second and third defendants, the first defendant had, in its restaurant bar, live-screened two earlier Premier League matches, without the requisite subscription, authorisation, license or permission of the plaintiffs. The copyrighted works appeared on those too. In the present action, the plaintiffs sought against the defendants, *inter alia*, declarations, injunctions, accounts and damages.

Held (defendants had infringed plaintiffs' copyright of copyrighted works):

(1) By making available the copyrighted works at their restaurant bar without the consent or license of any of the plaintiffs, the defendants had intervened, by enabling a direct link to be established between unauthorised sources of the copyrighted works and the patrons, without

which they would not have access to the copyrighted works. Thus, the defendants' acts constituted an act of communication. That act of communication was to the public because it was aimed at the patrons, indeterminate but more than *de minimis* number in number. That communication was to a segment of the public not contemplated by the plaintiffs when they authorised the initial communication of the copyrighted works. That initial authorisation was for transmission to subscribers of the second plaintiff's services *via* Astro, to receive such transmissions only in their own private or family circles. Therefore, the defendants' transmission was to a 'new public'. The defendants' said communication was clearly designed to attract more customers and therefore, increase the number of patrons. Being a restaurant bar, that would further positively affect the defendant's food and beverage business and, ultimately, its profitability thus calculated with a view to enhancing their profits. (para 25)

(2) The defendants' acts of showing, playing, screening, streaming the copyrighted works on a set-top box set up in the establishment to its patrons was (i) a communication to the public under s. 13(1)(aa) of the Copyright Act 1987 ('Act'); and (ii) performance, showing or playing to the publics under s. 13(1)(b) of the Act. The defendants had infringed the plaintiffs' copyright of the copyrighted works. (paras 26, 32 & 33)

Case(s) referred to:

Ernest Turner Electrical Instruments, Limited v. Performing Right Society, Limited Performing Right Society, Limited v. Gillette Industries, Limited [1943] Ch 167 ***(refd)***

Football Association Premier League Ltd And Others v. QC Leisure And Others; Murphy v. Media Protection Services Ltd (Joined Cases C-403/08 and C-429/08) [2012] Bus LR 1321 ***(refd)***

Performing Right Society Ltd v. Harlequin Record Shops Ltd [1979] 1 WLR 851 ***(refd)***

Performing Right Society, Limited v. Hammond's Bradford Brewery Company, Limited [1934] Ch 121 ***(refd)***

Rank Film Production Ltd v. Dodds (Trading as Town & Country Motel) [1983] 2 IPR 113 ***(refd)***

Socidedad General De Autores Y Editores De Espana (SGAE) v. Rafael Hoteles SA [2007] IP & T 521 ***(refd)***

Warner Music UK Ltd And Another v. Tuneln Inc [2021] EWCA Civ 441 ***(refd)***

Legislation referred to:

Copyright Act 1987, ss. 3, 13(1)(aa), (b), 36(1)(b)

Copyright, Designs and Patents Act 1988 [UK], s. 20(1), (2)

For the plaintiff - Chew Kherk Ying, Raymond Tan & Shueh Jing Koh; M/s Wong & Partners

For the defendant - Harvinder Singh Sidhu; M/s Vin Law Co

Reported by Najib Tamby

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JUDGMENT

Azlan Sulaiman JC:

The Final Whistle

[1] On 14 April 2022 close to 2.15pm in Liverpool, England, the Kop Stand at Anfield led the rapturous celebrations as Fabinho slotted home the penalty against Watford FC that secured the three points for the home-side and sent it top of the league. Again. Over 10,000 km away, patrons in a restaurant bar in Kuala Lumpur, seven hours ahead on the clock watching a live screening of the match on a set-top box set up in the establishment, joined in, the cacophony continuing up to and after the referee sounded the final whistle just minutes later. Little did the owners and patrons of that outlet know that they too were being watched. By the plaintiffs, for whom the final whistle was also the final straw.

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The Plaintiffs

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[2] The first plaintiff company is primarily involved in the business of organising the English Premier League competition. It also controls the worldwide audio-visual rights to all telecasts of Premier League matches – live and delayed – by licensing those audio-visual rights and transmission of audio-visual coverage of the matches to broadcasters in territories all around the globe.

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[3] In Malaysia, that license is presently given exclusively to the second plaintiff, who provides television and broadcasting services under the name and style of "ASTRO". That license includes the right to record, reproduce and/or re-broadcast the matches to its fee-paying subscribers.

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[4] To preserve and protect their 'gold mine', the plaintiffs took pains to copyright their respective artistic works/films (collectively, "the copyrighted works"). For the first plaintiff, these include its onscreen graphics and logos and all of the Premier League matches. For the second plaintiff, it includes the Astro and Astro Supersport logos, promos and other interstitials. All of the copyrighted works would have appeared several times on the first defendant's screen before, at half-time, and after the Liverpool-Watford game.

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The Earlier 'Fouls' And The 'Red Card'

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[5] Bar Theory Sdn Bhd, the first defendant, is not some lawyers' hypothesis, but would by this case find itself in need of legal representation. On the instigation of its directors, namely the second and third defendants, the first defendant had in its restaurant bar in KL live screened two earlier Premier League matches, on 26 February 2022 and 5 March 2022, all

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without the requisite subscription, authorisation, license or permission of the plaintiffs. The copyrighted works appeared on those too. The Liverpool match, obviously designed to attract many more patrons to the bar, was the last straw that had the plaintiff pull out their 'red card'. They appointed solicitors who on 18 July 2022 issued to the defendants a cease-and-desist letter to permanently refrain them from showing, playing, making available and/or communicating to the public the copyrighted works without the plaintiffs' express consent, authorisation and/or permission. They then filed this action in follow-up, claiming declarations, injunctions, an accounts, damages, interest and costs.

[6] Probably acknowledging that the 'red-card' was deserved, the defendants prudently chose not to dispute or resist the plaintiffs' claim, and indeed have not filed any affidavit challenging any of the plaintiff's narrative, including the plaintiffs' ownership of the copyrighted works. Instead, when counsel for the parties appeared before me on 5 October 2022 for directions for hearing, they informed me that they had mutually agreed for this matter to be disposed of on this court determining the declaration sought in prayer (1) of the originating summons (as amended), with the plaintiff agreeing to relinquish all the other relief in prayers (2) to (8), as well as the making of no order as to costs. I commend both parties for that pragmatism.

The Copyrighted Works

[7] For clarity, it would be best to set out the copyrighted works.

[8] The first plaintiff owns the copyright in the logos, graphics and film works set out in table A below, with copyright subsisting in Malaysia in each of them:

Table A

No.	Artistic Work/Films	Date Made
1.	First Onscreen Graphics	June to September 2019 and August 2020
2.	Additional Onscreen Graphics	August 2019, January 2021 and August 2021
3.	Onscreen Logo	January 2021
4.	Crystal Palace v. Burnley	26 February 2022
5.	Aston Villa v. Southampton	5 March 2022
6.	Liverpool v. Watford	2 April 2022

(collectively, the "Premier League's copyrighted works")

[9] The second plaintiff owns the copyright in the logos, graphics and film works set out in table B below, also with copyright subsisting in Malaysia in each of them:

Table B

No.	Artistic Work/Films	Date Made
1.	Astro Logo	May 2012
2.	Astro Supersport 3 Logo	May 2012
3.	Astro Supersports 3 channel logo bumper	May 2022
4.	Extended channel logo bumper for Astro Supersports 3	2 April 2022
5.	Astro Rewards scheme promo	2 April 2022
6.	Promo trailer for Astro produced and owned show: 'All Together Now – season 2'	2 April 2022
7.	Copyright notice with Astro Logo	2 April 2022
8.	'Coming Next' interstitial – Premier League	2 April 2022
9.	'Coming Next' interstitial – The Big Interview	2 April 2022

The Issue

[10] The sole issue that falls to be decided is:

> Whether the acts of showing, playing, screening, streaming to the public and/or communicating to the public in a business premises or otherwise, copyrighted works of the whole, or a substantial part thereof and/or causing the aforementioned, without the consent of the copyright owners, is an act of copyright infringement pursuant to s. 36 of the Copyright Act 1987.

[11] Firstly, though, I should point out that the defendants further elected to not file any written submissions. Without wishing in any way to downplay the plaintiffs' stands and the commendable efforts of plaintiffs' counsel in bringing to this court's attention decisions of the courts of other jurisdictions supporting their case, that defendants' election simply means that, in our adversarial system, this judgment is based on what the plaintiffs contend. Make no mistake; it was not a walkover. The plaintiffs still had to establish their case for copyright infringement. Which I believe they did.

Copyright Infringement

[12] Under the Copyright Act 1987 ("the Act"), copyright infringement is provided for under s. 36. Subsection (1) provides:

> Copyright is infringed by any person who does, or causes any other person to do, without the licence of the owner of the copyright, an act the doing of which is controlled by copyright under this Act.

[13] Section 13 of the Act prescribes the plaintiffs' exclusive rights of control of the Copyrighted Works in Malaysia. Here, the plaintiffs contend that, the defendants have infringed that exclusive control under limbs (aa) and (b) of sub-s. (1) to s. 13, namely:

> (aa) the communication to the public;
>
> (b) the performance, showing or playing to the public
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> of the whole work or a substantial part thereof, either in its original or derivative form ...

[14] Thus, breaking it down further, what this court will have to decided is whether the showing by the defendants of the copyrighted works on a set-top-box set-up in their restaurant bar on those dates was a communication to the public and/or the performance, showing or playing to the public.

Communication To the Public

[15] Section 3 of the Act provides that "communication to the public" means:

> the transmission of a work or performance through wire or wireless means to the public, including the making available of a work or performance to the public in such a way that members of the public may access the work or performance from a place and at a time individually chosen by them

[16] Very similar words appear in the art. 3(1) of EC Directive 2001/29 which requires member states to:

> provide authors with the exclusive right to authorise or prohibit any communication to the public of their works, by wire or wireless means, including the making available to the public of their works in such a way that members of the public may access them from a place and at a time individually chosen by them.

[17] Recital 23 of EC Directive 2001/29 reads as follows:

> This Directive should harmonise further the author's right of communication to the public. This right should be understood in a broad sense covering all communication to the public not present at the place where the communication originates. This right should cover any such transmission or retransmission of a work to the public by wire or wireless means, including broadcasting.

[18] In *Socidedad General De Autores Y Editores De Espana (SGAE) v. Rafael Hoteles SA* [2007] IP & T 521, SGAE, the intellectual property rights management society of Spain, brought an action against the defendant, the owner of Hotel Rafael. It alleged that, between June 2002 to March 2003, Hotel Rafael had communicated to its guests through television sets installed in its rooms works belonging to the repertoire owned by SGAE. The signals were received by the hotel's main antenna and then distributed to those television sets. One of the questions that was subsequently referred to the EU Court of Justice was:

> Does the installation in hotel rooms of television sets to which a satellite or terrestrial television signal is sent by cable constitute an act of communication to the public which is covered by the harmonisation of national laws protecting copyright provided for in Article 3 of Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001.

[19] The EC Court of Justice held that, while merely providing physical facilities like television sets, *etc.* does not of itself constitute a communication to the public within the meaning of that directive, if by means of those facilities the hotel distributes the signal to its guests staying in its rooms, then communication to the public takes place, irrespective of the technique used to transmit the signal. In other words, it is the transmission that counts.

[20] A few years later, the first plaintiff's own claims for copyright infringement were also referred to the EC Court of Justice, whose judgment is reported in *Football Association Premier League Ltd And Others v. QC Leisure And Others; Murphy v. Media Protection Services Ltd (Joined Cases C-403/08 and C-429/08)* [2012] Bus LR 1321. The first plaintiff's licensees would transmit the satellite signal of the first plaintiff's works in encrypted form to its subscribers, who required decoder boxes and cards to decrypt the signal. However, much to the first plaintiff's chagrin, decoder cards produced outside of the UK that could also intercept and transmit that satellite signal were sold to publicans in the UK, who were then able to show Premier League matches at a more favourable price. The first plaintiff then brought test actions against several suppliers of those cards and publicans, in respect of which several questions were then referred to the EC Court of Justice. The first part of the sixth of those questions was:

> Is a copyright work communicated to the public by wire or wireless means within the meaning of article 3 of the Copyright Directive where a satellite broadcast is received at a commercial premises (for example a bar) and communicated or shown at those premises *via* a single television screen and speakers to members of the public present in those premises.

[21] In its judgment, the EC Court of Justice held, *inter alia*: A

(i) The concept of communication must be interpreted broadly.

(ii) The proprietor of a public house intentionally gives the customers present in that establishment access to a broadcast containing protected works *via* a television screen and speakers. Without his intervention, the B customers would not enjoy the works broadcast, even though they are physically within the broadcast's catchment area. Thus, he effects a communication.

(iii) For there to be "communication to the public", a further prerequisite is that the work broadcast be transmitted to a 'new public', *ie*, a public C outside the contemplation of the authors of the protected works when they authorised their use by the communication to the original public. When they did authorise a broadcast of their works, in principle they would have considered only the owners of television sets who, either personally or within their own private or family circles, receive the D signal and follow the broadcasts.

(iv) Where a broadcast work is transmitted in a place accessible to the public for an additional public which is permitted by the owner of the television set to hear or see the work, an intentional intervention of that kind must be regarded as an act by which the work in question is E communicated to a new public.

(v) The transmission of the works broadcast by the proprietor of a public house to the customers present in that establishment is to an additional public not considered by the authors when they authorised the broadcasting of their works. F

(vi) Even though "communication" within the meaning of art. 3(1) of the copyright directive need not necessarily be premised on profit-making, it is indisputable that the proprietor transmitted the broadcast works in his public house in order to attract customers and benefit therefrom, and G thereby effect the number of persons going to that establishment and its financial results.

(vii) Consequently, "communication to the public" within the meaning of art. 3(1) of the copyright directive must be interpreted as covering transmission of the broadcast works, *via* a television screen and speakers, H to the customers present in a public house.

[22] In *Warner Music UK Ltd And Another v. Tuneln Inc* [2021] EWCA Civ 441, the plaintiff and the groups of companies it represented owned or held exclusive licenses to copyright in sound recordings of music. The defendant operated a browsable and searchable platform, available online and *via* an I app, which enabled users to select and listen to music radio stations from around the world, and also offered a paid-for app which allowed the users

A to record from the radio. The plaintiff contended that a communication to the public for the purposes of s. 20 of the Copyright, Designs and Patents Act, 1988 occurred, when sound recordings from their repertoire were played on a station to whom UK users of the defendant's platform had linked. The said s. 20(1) and (2) of the Copyright, Designs and Patents Act 1988 B provided:

> Infringement by communication to the public
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> (1) The communication to the public of the work is an act restricted by the copyright in:
>
> C (a) a literary, dramatic, musical or artistic work,
>
> (b) a sound recording or film, or
>
> (c) a broadcast.
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> (2) References in this Part to communication to the public are to communication to the public by electronic transmission, and in relation to D a work include:
>
> (a) the broadcasting of the work;
>
> (b) the making available to the public of the work by electronic transmission in such a way that members of the public may access it from a place and at a time individually chosen by them. E

[23] Arnold LJ set out some broad principles regarding "communication to the public", *inter alia*:

(i) 'Communication to the public' must be interpreted broadly.

F (ii) 'Communication to the public' covers any transmission or retransmission of the work to the public does not present at the place where the communication originates by wire or wireless means, including broadcasting.

(iii) There is no 'communication to the public' where the viewers have no G access to an essential element which characterises the work.

(iv) 'Communication to the public' involves two cumulative criteria: first, an 'act of communication' of a work, and secondly, the communication of that work to a 'public':

H (v) 'Communication' refers to any transmission of the work, irrespective of the technical means or process used.

(vi) Every transmission or retransmission of the work by a specific technical means must, as a rule, be individually authorised by the right holder.

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(vii) A user makes an act of 'communication' when it intervenes, in full knowledge of the consequences of its action, to give its customers access to a protected work, particularly where, in the absence of that intervention, those customers would not be able to enjoy the work or would be able to do so only with difficulty.

(viii) It is sufficient for there to be 'communication' that the work is made available to the public in such a way that the persons forming that public may access it, whether or not those persons actually access the work.

(ix) Mere provision of physical facilities does not as such amount to 'communication'. Nevertheless, the installation of physical facilities which distribute a signal and thus make public access to works technically possible constitutes 'communication'.

(x) 'The public' refers to an indeterminate number of potential recipients and implies a fairly large number of persons. 'Indeterminate' means not restricted to specific individuals belonging to a private group; and 'a fairly large number of people' indicates that the concept of 'public' encompasses a certain de minimis threshold, which excludes from the concept groups of persons which are too small, or insignificant. For that purpose, the cumulative effect of making the works available to potential recipients should be taken into account.

(xi) In considering whether there is a communication to 'the public', it is not irrelevant that the communication is of a profit-making nature, and a profit-making nature is not necessarily an essential condition for a communication to the public.

[24] Bearing in mind that this court is not bound by any of those decisions, I am nevertheless persuaded to apply some of those principles espoused here, more so when art. 3(1) of the EU Copyright Directive and s. 20(1) and (2) of the Copyright, Designs and Patents Act 1988 (UK) are very similar to our s. 13 of the Act.

[25] I would therefore agree with the plaintiffs' submissions that:

(i) By making available the copyrighted works at their restaurant bar without the consent or licence of any of the plaintiffs, the defendants have intervened by enabling a direct link to be established between unauthorised sources of the copyrighted works and the patrons, without which they would not have access to the copyrighted works. Thus, the defendants' acts constitute an act of communication.

(ii) That act of communication is to the public, because it is is aimed at the patrons, indeterminate but more than *de minimis* number in number.

(iii) That communication was to a segment of the public not contemplated by the plaintiffs when they authorised the initial communication of the copyrighted works. That initial authorisation was for transmission to subscribers of the second plaintiff's services *via* Astro, to receive such transmissions only in their own private or family circles. Thus, the defendants' transmission was to a "new public".

(iv) Though not a critical prerequisite, the defendants' said communication was clearly designed to attract more customers and therefore increase the number of patrons. Being a restaurant bar, that would further positively affect the defendants' F&B business and ultimately, its profitability thus calculated with a view to enhancing their profits.

[26] I would therefore hold that the defendants' acts of showing, playing, screening, streaming the copyrighted works on a set-top-box set-up in the establishment to its patrons was a communication to the public under s. 13(1)(aa) of the Act.

Performance, Showing Or Playing To The Public

[27] For this, the plaintiffs also relied to several case authorities, which I shall refer to chronologically.

[28] In *Performing Right Society, Limited v. Hammond's Bradford Brewery Company, Limited* [1934] Ch 121, the plaintiff permitted by license the BBC to broadcast some of their copyrighted songs. Through a receiving-set and loudspeakers, the defendant, played those musical works to its guests at the hotel it owned. Lord Hanworth MR said:

> By the use of what I have called an installation, they made this performance at Hammersmith audible to a larger number of persons than would otherwise have heard it and to persons outside the domestic circle of the George Hotel. It was at the instance of the management that steps were taken to provide this entertainment. It appears to me that that act on the part of the management constituted on their part either a performance or the authorisation of a performance.

[29] In *Ernest Turner Electrical Instruments, Limited v. Performing Right Society, Limited Performing Right Society, Limited v. Gillette Industries, Limited.* [1943] Ch 167, the owners of a factory, in an effort to prevent boredom and increase efficiency and output of their employees, broadcast by means of amplifiers and loud speakers, programmes of music by the BBC, some of which belonged to the performing right society. The Court of Appeal held that the performance of music was a performance in public.

[30] In *Performing Right Society Ltd v. Harlequin Record Shops Ltd* [1979] 1 WLR 851, the defendant who owned some 50 record stores continuously blared songs in which the performing right society owned the copyright over loudspeakers in those stores but refused to pay license fees for doing so. Browne-Wilkinson J said:

> In my judgment a performance given to an audience consisting of the persons present in a shop which the public at large are permitted, and indeed encouraged, to enter without payment or invitation, with a view to increasing the shop owner's profit, can only properly be described as a performance "in public." I do not think the decisions relied on provide any authority for attaching to the words "in public" a special meaning which, in ordinary usage, they cannot bear.

[31] In *Rank Film Production Ltd v. Dodds (Trading as Town & Country Motel)* [1983] 2 IPR 113 decided by the Supreme Court of New South Wales, the defendant provided television sets in the rooms at its motel and from time to time transmitted to some of them films, some belonging to the plaintiff, by means of a video cassette recorder connected to those sets by wire. Rath J held that the performances of the films were in public. He said:

> The words "in public" in s. 86(b) must be construed in the context of the history of the copyright legislation and the case law (a summary of which is to be found in the judgment of Lord Wright in *Jennings v. Stephens*, *supra*, esp at 475). Performance "in public" means performance to the public of the owner of the copyright, and "public" includes a portion of the public, however smalf.

[32] Again stressing that this court is not bound to follow these cases, I would nevertheless agree and hold that the defendants' acts of showing, playing, screening, streaming the copyrighted works on a set-top-box set-up in the establishment to its patrons was also performance, showing or playing to the public under s. 13(1)(b) of the Act.

Conclusion

[33] As the defendants had communicated the copyrighted works to the public and had performed, showed and played the copyrighted works for the public without the plaintiffs' license and consent, then the irresistible conclusion is that they had infringed the plaintiffs' copyright of the copyrighted works.

[34] therefore declare, as per prayer (1) of the originating summons (as amended) that the acts of showing, playing, screening, streaming to the public and/or communicating to the public in a business premises or otherwise, copyrighted works of the whole, or a substantial part thereof and/or causing the aforementioned, without the consent of the copyright owners, is an act of copyright infringement under s. 36 of the Copyright Act 1987.

[35] As further agreed between the parties, I make no order as to costs.